

APR. 13. 2004 5:24PM

HOWREY SIMON ARNOLD

NO. 0231 P. 55

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# EXHIBIT F

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NO. 0231 P. 56  
EPI-00672



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/093,972	06/09/99	NYCE	J P6641031

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HM22/0608

EXAMINER

EPPS, J

ART UNIT	PAPER NUMBER
1636	38

DATE MAILED:

06/08/01

Appeal by due 7/4/01  
5XT 12/4/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**

Application No.	Applicant(s)
09/093,972	NYCE, JONATHAN W.
Examiner	Art Unit
Janet L Epps	1635

*—The MAILING DATE of this communication appears on the cover sheet with the correspondence address—*

THE REPLY FILED 24 May 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check only a) or b)]**

a)  The period for reply expires \_\_\_\_ months from the mailing date of the final rejection.  
 b)  In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on 04 May 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search. (see NOTE below);
  - (b)  they raise the issue of new matter. (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

4.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
5.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
7.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8.  For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
 

Claim(s) allowed: 108-131, 133, 134, 146, 148, 151-156, 161-163 and 232-234.

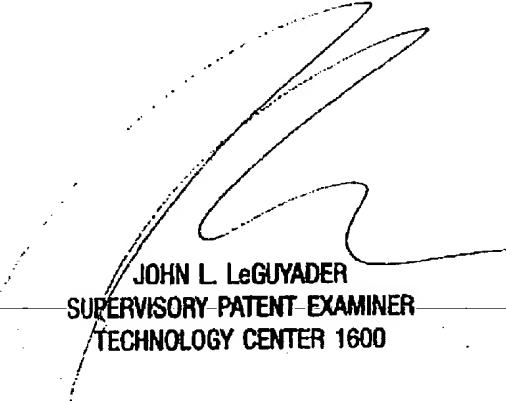
Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 164-231.

Claim(s) withdrawn from consideration: \_\_\_\_\_.
9.  The proposed drawing correction filed on \_\_\_\_\_ a) has b) has not been approved by the Examiner.
10.  Note the attached Information Disclosure Statement(s) ( PTO-1449) Paper No(s). \_\_\_\_\_.
11.  Other: \_\_\_\_\_

Continuation of 3. NOTE: Applicants have made additional changes to the claims that were not previously agreed upon during the last telephonic interview held 5-21-01.

- 1) Claim 164 was amended to recite "increased levels of, adenosine or adenosine receptors," Instead of "increased levels of adenosine." Additionally, claim 164 was also amended to recite oligos anti-sense to "a gene encoding or regulating the expression of a protein" instead of "a gene encoding a protein," these two changes alone to claim 164 raise new issues that would require further consideration due to new matter since neither change is supported by the specification as filed.
- 2) Claim 173 was amended to recite wherein at least one oligonucleotide is effective to alleviate hyper-responsiveness to, and/or increased levels of adenosine or adenosine receptors, and was further amended to recite oligos anti-sense sense to a gene controlling expression of a protein associated with hyper-responsiveness to and/or increase levels of adenosine or adenosine receptors. Applicant's specification does not indicate that they are not in possession of such oligos. Therefore, the invention as a whole would have been prima facie obvious at the time of filing over these changes would raise new issues under 35 USC § 112, first paragraph for new matter.
- 3) Claims 185-187, and 221-222 were also amended to recite "increased levels of, adenosine or adenosine receptors," instead of "increased levels of adenosine." Again the scope of this amendment is not supported by the specification as filed and would therefore raise the issue of new matter under 35 USC § 112, first paragraph.
- 4) Claim 200 is amended to recite wherein the oligo comprises a fragment that has a T/U nucleic acid content of up to and including 15%. This amendment is not supported by the specification, since the specification and original claims supports only a description of the A, C and G content of the oligo, not the T/U content. This change would also raise the issue of new matter.



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